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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,731	07/28/2003	Manish K. Deliwala	03292.101710.	4018
66569 7590 11/24/2009 FITZPATRICK CELLA (AMEX) 1290 Avenue of the Americas NEW YORK, NY 10104-3800				
EXAMINER				
OBEID, FAHD A				
ART UNIT		PAPER NUMBER		
3627				
MAIL DATE		DELIVERY MODE		
11/24/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/628,731

Applicant(s)

DELIWALA ET AL.

Examiner

FAHD A. OBEID

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/22)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Status of the Application

1. **Claims 1-4** are pending in this application.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/06/2009 has been entered.

Preliminary Remarks

3. This is in reply to application filed on 11/06/2009.
4. No claims have been added or cancelled.
5. Claim 1 has been amended.
6. Claims 1-4 are currently pending and have been examined.

Specification Objections

7. The amendment filed 11/06/2009 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "matching each of the plurality of unique

identifiers to one or more of the computer related hardware processing tasks performed by each group”.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicant's amendment filed on 11/06/2009 contains the limitation “matching each of the plurality of unique identifiers to one or more of the computer related hardware processing tasks performed by each group”.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recite the limitations “the billing information including a plurality of computer-related hardware processing jobs executed by the provider for the entity and a corresponding plurality of unique identifiers” and “application profiles information including associations of one or more computer-related hardware processing tasks that utilize one or more of the plurality of computer-related hardware processing jobs, executed by the provider to each group and to a one or more of the unique identifiers” are vague and indefinite. It is unclear and confusing if the computer-related hardware processing jobs are equivalent to computer-related hardware processing tasks. If they are equivalent then the applicant will need to use either one and maintain the relationship throughout the claims. If they are different, then the applicant will need to clarify the difference. Thus the limitation is not positively recited.

Claim 1 recite the limitations “the billing information including a plurality of computer-related hardware processing jobs... and a corresponding plurality of unique identifiers” and “application profile information including associations of one or more computer-related hardware processing tasks... to each group and to one or more of the unique identifiers” are vague and indefinite. It is unclear and confusing how the association of a plurality of computer-related hardware processing tasks to each group and to the computer-related hardware processing jobs (unique identifiers). Applicant will need to clarify how the association of the computer-related hardware processing tasks and the computer-related hardware processing jobs are performed. In other words what is the difference and relationship between tasks and jobs since the specification does not provide sufficient information to enable an ordinary person in the art to understand the difference.

Claim Rejections - 35 USC § 101

12. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-4 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In *re Bilski et al*, 88 USPQ 2d 1385 CAFC (2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps are not tied to a particular machine and do not perform a transformation. Thus, the claims are non-statutory.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. *Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.*

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

15. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over MacFarlane (US 6,125,354) in view of Peterson (US 7,020,628).

16. Regarding Claim 1: MacFarlane discloses a method for tracking costs incurred by an entity comprising a plurality of groups, the method comprising:

- Reading a business model (organization hierarchy) file comprising at least one business dimension within the entity, the at least one business dimension including (col 1 lns 27-42 and col 3 lns 54-63):
- Organizational information including a list of a plurality of groups within the entity, and application profiles information including associations of one or more computer-related hardware processing tasks that utilize one or more of the plurality of computer-related

hardware processing jobs, executed by the provider to each group and to a one or more of the unique identifiers (fig.5 and col 6 lns 61-64);

- Allocating the billing information by the at least one business dimension including matching each of the plurality of unique identifiers to one or more of the computer related hardware processing tasks performed by each group (fig.5, col 2 lns 58-67, col 6 lns 57-64, and col 9 lns 25-35).

MacFarlane does not explicitly disclose receiving billing information associated with consumption of computer-related hardware processing resource from a provider.

However, Peterson does disclose the following:

- Receiving billing information associated with consumption of computer-related hardware processing resource from a provider, the billing information including a plurality of computer-related hardware processing jobs executed by the provider for the entity and a corresponding plurality of unique identifiers (abstract, col 1 lns 17-18, and col 4 lns 7-10).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use Peterson's teachings in MacFarlane's "system and method for generating an invoice charges to the elements of an organization" enabled, for the advantage of monitoring the costs of remote users accessing the computer of the company (Peterson; col 1 lns 27-29).

17. Regarding Claim 2: MacFarlane discloses the method of claim 1 wherein the at least one business dimensions further comprises:

- At least one business process (col 4 lns 7-9 and col 3 lns 54-63).
- An associated business performance metrics (abstract and col 2 lns 45-57).

18. Regarding Claim 3: MacFarlane discloses the method of claim 2 wherein the allocating step further comprises:

- determining a total cost incurred by at least one of the plurality of groups (col 1 lns 27-35, col 2 lns 58-67, col 6 lns 57-59, and col 9 lns 25-35).

19. Regarding Claim 4: MacFarlane discloses the method of claim 1 wherein the reading step further comprises:

- Determining an internal structure of the entity, including the plurality of groups within the entity (col 1 lns 27-35).
- Determining a billing detail of the plurality of groups within the entity (fig.1, col 4 lns 45-48, and col 7 lns 10-14).
- Determining a value driver of the entity (claim 1).
- Determining an application profile of the entity (col 4 lns 6-8).

Response to Arguments

20. Applicant's arguments have been fully considered but they are not persuasive. In particular the applicant alleges that MacFarlane and Peterson do not teach: a) the unique identifiers do not identify the user of the technology resources, but rather identify the job and hence task the technology resource was used to accomplish. Therefore the prior art do not teach or suggest unique identifiers which identify computer-related hardware processing jobs.

In response to a) examiner respectfully disagrees, Peterson teaches a system and method of tracking computer usage, and costs associated with the computer usage (col 1 lns 17-18). Monitoring the costs of remote users accessing the host computer or computer network of the company, in addition to tracking the usage of computer time and various costs associated with that time (col 1 lns 27-30). Also, the costs associated with remotely dialing up an organization's computer facilities, such as the telephone line charges, are reported separately by each of the one or more long distance line carriers utilized by the remotely located computer users (col 1 lns 33-37). Manipulating the usage and billing data for each of a number of different host computer networks by individual user and by predetermined groups or departments of users at each organization (col 1 lns 58-62). Monitoring access to each of the host computer networks, each computer network provides an associated list of authorized users that is maintained at the ISC, ESS, and NAS. An authorized user accessing a host computer exchanges the information with the NAS via the communication server, each time the user dials in to gain access to his respective host computer network a starting time stamp is created at the beginning of each remote access call received from a user at the communication server (col 3 lns 33-43). The NAS receives an ending time stamp from the communication server at the conclusion of the remote access call when the user hangs up or otherwise disconnects from the host computer network. Following the conclusion of the remote access call, the service bureau stores the starting and ending time stamps in the NAS memory. The starting and ending time stamps are associated in the user log with the list of authorized users so that the user log contains a record of computer time usage for each authorized user (col 4 lns 1-10). Therefore, the computer usage with the starting and ending time stamps are stored in a memory and are associated in the user log. The

user log contains a record of computer time usage for each authorized user which is equivalent to “computer related hardware processing jobs and corresponding unique identifiers”.

Therefore, MacFarlane in view of Peterson still meet the scope of the limitation as currently claimed.

Conclusion

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to FAHD A. OBEID whose telephone number is (571)270-3324. The examiner can normally be reached on Monday to Friday 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Ryan Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Fahd A Obeid/
Examiner, Art Unit 3627
November 19, 2009

/F. Ryan Zeender/
Supervisory Patent Examiner, Art Unit 3627